

REMARKS

Applicants thank the Examiner for total consideration given the present application. Claims 1-18 are currently pending of which claims 1, 6-8, 10, 15-17 are independent. Claims 1, 6-8, 10, 15-17 have been amended through this Reply. Upon careful review, one would conclude that no new matter has been added to the application via this amendment. Applicants respectfully request reconsideration of the rejected claims in light of the remarks presented herein, and earnestly seek timely allowance of all pending claims.

Claim Rejection - 35 U.S.C. § 101

Claims 1-9 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Particularly, the Examiner alleges that these claims are directed to system comprising “software per se”. Applicants again respectfully traverse this rejection.

First, it is again respectfully submitted that the Examiner’s characterization of the claimed invention as a system comprising “software per se” is totally illogical. The Examiner acknowledges that the claimed invention is directed to a “system”. A “system” by its definition is a “physical object” or a “machine”, which are statutory under 35 U.S.C. § 101. Such system simply cannot merely comprise “software per se” as alleged by the Examiner.

Second, independent claims 1, 6, and 7 are each directed to a media delivering “apparatus” which comprises “a parameter acquiring unit”; “a transmission-data generating unit”; a data transmitting unit”; and “a media communication unit” wherein each of these units performs specific functionality. Independent claim 8 is directed to a media receiving “apparatus” which comprises “a data receiving unit”; “a data analyzing unit”; “an RTSP communication unit”; and “a media display unit” transmission-data generating unit”; a data transmitting unit”; and “a media communication unit” wherein each of these units performs specific functionality. All of the above-identified units are “physical objects” not “software per se” as alleged by the Examiner.

In response to our previously filed arguments, the Examiner merely alleges that the claimed invention does not include at least one physical part of a device. Applicants respectfully disagree with the Examiner. The Examiner is respectfully requested to study the instant

specification thoroughly where functionality of the each above-identified units have been described in relation to both hardware and software component. For example, the specification clearly describes media data as “video images” generated by video cameras. Further, the specification describes that the media data (e.g., video images) is displayed by the media receiving apparatus. (*See for example, pages 13 and 14 of the instant specification.*) Thus, at least the media receiving apparatus includes hardware component which displays media data as video images.

Therefore, for at least these reasons, it is respectfully submitted that claims 1-9 are statutory under 35 U.S.C. § 101. If the Examiner continues to maintain this rejection, the Examiner is again requested to provide detail explanations as to why the claims are non-statutory. A mere statement that “the word “system” does not inherently means that the claim is directed to a machine” without providing any detailed analysis is not sufficient to allege that the claims are non-statutory.

Accordingly, it is respectfully requested that this rejection be withdrawn.

35 U.S.C. § 102 Rejection- Shinohara

Claims 1-18 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Shinohara (US 7,310,514 B2). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. *See M.P.E.P. 2131; M.P.E.P. 706.02.* Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

Independent claims 1, 6, and 7 are each directed to a “media delivering apparatus” which comprises, *inter alia*, “a parameter acquiring unit for acquiring at least one of a communication capability of said network and a receiving capability of said media receiving apparatus as a parameter.” (*Emphasis added.*) It is respectfully submitted that Shinohara fails to teach or suggest the above-identified claim feature.

As previously submitted, Shinohara merely discloses a conventional multimedia communication system in which a media delivering apparatus, such as mobile telephone 10₁, sends multimedia messages to a media receiving apparatus, such as mobile telephones 10₂-10₄, via a network 60. (*See Fig. 3.*)

For example, when each of mobile telephones 10₁-10₄ as shown in Fig. 3 is first connected to network 60 upon turning on the power supply, information regarding the media types and formats that can currently be received as messages is transmitted to server 30. Each of mobile telephones 10₁-10₄ transmits in any way new information regarding the processing capability for each media type to server 30 when an external terminal is connected and the processing capability for each media type changes while the power supply is turned on. (*See col. 6, lines 29-38.*)

The server 30 first determines whether the multimedia message that is to be transmitted by mobile telephone 10₁ can be received at transmission-destination mobile telephones 10₂-10₄, and then notifies mobile telephone 10₁ of these determination results. (*See col. 7, lines 6-10.*)

Shinohara is distinguished from the claimed invention in that nowhere does Shinohara teach or suggest that the media delivering apparatus (mobile telephone 10₁) includes a parameter acquiring unit which acquires communication capability of network 60 via which multimedia message may be sent to mobile telephones 10₂-10₄ as a parameter. Shinohara merely suggests that mobile telephone 10₁ may require processing capability of mobile telephones 10₂-10₄ to determine whether to send multimedia message based on the results provided by server 30. Neither the cited portion nor any other portions of Shinohara teaches or suggests that mobile telephone 10₁ acquires communication capability of network 60 as a parameter.

In response to the above-identified arguments, the Examiner now alleges that since Shinohara mobile telephones include Code Division Multiple Access (CDMA) capability, Shinohara anticipates the claimed feature of “a parameter acquiring unit for acquiring both a communication capability of said network and a receiving capability of said media receiving apparatus.” Particularly, the Examiner now relies on col. 2, lines 4-10 as disclosing the above-identified claim feature. The fact that a certain result or characteristic may occur or be present in

the prior art is not sufficient to establish the inherency of that result of characteristic. In relying upon the theory of inherency, the Examiner must demonstrate that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See *M.P.E.P. 2112*. The Examiner's reliance on the phrase recited in col. 2, lines 7-10 that "[i]n these next-generation mobile telephone systems, it will be possible to transmit and receive a variety of data including text, graphics, video, and audio, as messages" does not inherently establish that these next-generation mobile telephone systems would include a parameter acquiring unit to transmit and receive data relating to communication capability of a network as a parameter.

The Examiner is again reminded that to establish a *prima facie* case of anticipation, the cited reference must expressly or inherently teach all claim limitations. In this instance, it is respectfully submitted that Shinohara neither expressly nor inherently teach or suggest, *inter alia*, "a parameter acquiring unit for acquiring at least one of a communication capability of said network and a receiving capability of said media receiving apparatus as a parameter."

Shinohara merely suggests that the mobile telephones 10₁-10₄ communicate with each other via network 60 by way of wireless lines, for example CDMA. This does not anticipate that mobile telephone 10₁ includes a parameter acquiring unit for acquiring communication capability of the network 60. CDMA is a specific way of communication in a multimedia communication system. CDMA capability for mobile telephone 10₁ means that it will communicate with mobile telephones 10₂-10₄ by the specific code division multiple access communication method via network 60. Nowhere does Shinohara teach or suggests that this CDMA capability will expressly or inherently allow mobile telephone 10₁ to acquire information regarding the communication capability of network 60 as a parameter.

In addition, the Examiner alleges that the claim does not recite what the "parameter acquiring unit" is performing or manipulating. The Examiner's such allegation is totally unfounded. The claims clearly recite that the parameter acquiring unit acquires at least one of a communication capability of said network a receiving capability of said media receiving apparatus as a parameter

Further, it is respectfully submitted that Shinohara fails to teach or suggest, *inter alia*, “a media selecting unit for selecting media data to be delivered based on both a degree of media importance as a parameter assigned to each of said media data and at least the one of said communication capability of said network and said receiving capability of said media receiving apparatus” as recited in independent claims 1, 6, and 7. (*Emphasis added.*)

The Examiner relies on col. 6, lines 62-67 of Shinohara as disclosing the above-identified feature. It is respectfully submitted that the Examiner’s interpretation of the relied upon section of Shinohara is clearly erroneous. The relied upon section merely suggest that before transmitting a multimedia message having a particular format, the mobile telephone 10₁ notifies the database server 30 of information regarding the formats for each media type. Neither the cited portion, nor any other portions of Shinohara teaches or suggests that a degree of media importance as a parameter is assigned to each media type. One cannot ascertain a degree of media importance as a parameter for each media type from mere information regarding the formats for each media type.

Therefore, for at least these reasons, Shinohara is distinguishable from claims 1, 6, and 7.

Independent claim 8 is directed to a media receiving apparatus which comprises a data receiving unit for receiving metadata based on “a degree of media importance” and at least one of a “communication capability of said network” and “receiving capability” of the media receiving apparatus “as a parameter”. As demonstrated above, during transmission of multimedia messages from mobile telephone 10₁ to mobile telephones 10₂-10₄, mobile telephone 10₁ may receive processing capability of mobile telephones 10₂-10₄ (media receiving apparatus) to determine whether to send the multimedia messages to these receiving apparatus. None of these media receiving apparatuses (mobile telephones 10₂-10₄) include a data receiving unit for receiving metadata based on communication capability of network 60 as a parameter. Further, at least for the reasons set forth above with respect to claims 1, 6, and 7, it is respectfully submitted that Shinohara fails to teach or suggest, *inter alia*, “a data receiving unit for, based on a degree of media importance as a parameter assigned to each of said media data and at least

one of a communication capability of said network and a receiving capability of said media receiving apparatus as a parameter” as recited in claim 8.

Therefore, for at least these reasons, Shinohara is distinguishable from claim 8.

Accordingly, it is respectfully submitted that independent claims 1 and 6-7 are allowable over Shinohara. Claims 2-5 and 9 are at least allowable by virtue of their dependency on allowable independent claim and further in view of novel features recited therein.

Claims 10-18 are directed to method claims corresponding to apparatus claims 1-9. Thus, at least for the reasons set forth above with respect to claims 1-9, claims 10-18 are also allowable over Shinohara.

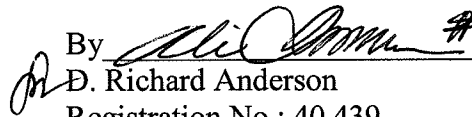
CONCLUSION

In view of the above amendment, Applicants believe the pending application is in condition for allowance. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Ali M. Imam Reg. No. 58,755 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

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